

Docket No. 1293.1282

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Sung-wook PARK et al.

Application No. 09/981,288

Group Art Unit: 2621

Confirmation No. 5004

Filed: October 18, 2001

Examiner: Gelek W. Topgyal

For: DATA STORAGE MEDIUM IN WHICH MULTIPLE BITSTREAMS ARE RECORDED,
APPARATUS AND METHOD FOR RECORDING THE MULTIPLE BITSTREAMS, AND
APPARATUS AND METHOD FOR REPRODUCING THE MULTIPLE BITSTREAMS (As
Amended)

APPLICANTS' STATEMENT OF SUBSTANCE OF INTERVIEWS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Interview Summary mailed October 7, 2008, for the telephone interview conducted on September 8, 2008, between Examiner Gelek W. Topgyal and the undersigned attorney, Randall S. Svhila, is acknowledged. Also, the revised Interview Summary for the telephone interview of September 8, 2008, attached to the Final Office Action mailed October 17, 2008, is acknowledged. The applicants' statement of the substance of the interview required by the Interview Summaries and MPEP 713.04 appears below.

On September 5, 2008, the undersigned attorney, Randall S. Svhila, reviewed the Final Office Action of September 3, 2008, and discovered that Examiner Gelek W. Topgyal had repeated the rejection of claims 1-4 under 35 US 101 as being directed to non-statutory subject matter and had also included new claim 48 in the rejection, but had changed the basis for the rejection from the claims allegedly not reciting a computer-readable medium to the claims allegedly reciting nonfunctional descriptive material.

That same day, September 5, 2008, the attorney left a voice mail message for the Examiner stating that this constituted a new ground of rejection that was not necessitated by the

Amendment of April 22, 2008, and asking the Examiner to issue an Interview Summary withdrawing the finality of the Final Office Action of September 3, 2008, and restarting the period for response.

On September 8, 2008, the Examiner called the attorney back and stated that upon further review, the Examiner and his supervisor had decided to withdraw the rejection of claims 1-4 and 48 under 35 USC 101 and maintain the finality of the Final Office Action. The Examiner stated that he would issue a replacement Final Office Action without the rejection under 35 USC 101 and restarting the period for response.

On September 26, 2008, the attorney checked on the status of the application and discovered that the replacement Final Office Action had not yet been issued, and left a voice mail message for the Examiner that same day asking about the status of the replacement Final Office Action.

On September 29, 2008, the attorney had not heard from the Examiner, so the attorney sent him the Examiner an e-mail asking about the status of the replacement Final Office Action and asking the Examiner to issue the replacement Final Office Action in time for the attorney to receive it by October 3, 2008, or to fax the attorney an Interview Summary for the telephone interview of September 8, 2008, stating that the rejection under 35 USC 101 had been withdrawn; that a replacement Final Office Action restarting the period for response would be issued in due course; and that the applicants do not need to file a response to the Final Office Action of September 3, 2008.

That same day, September 29, 2008, the Examiner sent the attorney an e-mail stating that the Examiner would be sending out the replacement Final Office Action with an Interview Summary for the telephone interview of September 8, 2008, attached, and that the Examiner would also fax the attorney a copy of the Interview Summary.

That same day, September 29, 2008, the attorney sent the Examiner an e-mail acknowledging the Examiner's e-mail of September 29, 2008.

On September 30, 2008, the Examiner faxed the attorney an Interview Summary for the telephone interview of September 8, 2008, stating as follows:

Upon further review, the rejection of claims 1-4 and 48 under 35 USC 101 in the Final Office Action of September 3, 2008, is withdrawn. A replacement Final Office Action restarting the period

for response will be issued in due course. The applicants do not need to file a response to the Final Office Action of September 3, 2008.

However, on October 1, 2008, the Examiner sent the attorney an e-mail stating that the Examiner and his supervisor had decided that it was not necessary to restart the period for response because they had simply removed the rejection under 35 USC 101 from the Final Office Action of September 3, 2008. The e-mail stated that the Examiner would fax the attorney another Interview Summary stating only that the rejection under 35 USC 101 had been withdrawn. However, the Examiner never faxed the attorney this other Interview Summary.

That same day, October 1, 2008, the attorney sent the Examiner an e-mail stating as follows:

Actually, we are entitled to have the period restarted pursuant to MPEP 710.06, which provides as follows in pertinent part:

where the citation of a reference is incorrect or an Office action contains some other error that affects applicant's ability to reply to the Office action and this error is called to the attention of the Office within 1 month of the mail date of the action, the Office will restart the previously set period for reply to run from the date the error is corrected, if requested to do so by applicant.

Here, the Final Office Action of September 3, 2008, contained an error that affected our ability to reply because the finality was premature because the Final Office Action included a new ground of rejection under 35 USC 101 based on non-functional descriptive material that was not necessitated by the applicants' amendment of the claims, and what we can do in response to a Final Office Action is much more limited than what we can do in response to a non-final Office Action. You have corrected the error by withdrawing the new ground of rejection under 35 USC 101, and pursuant to MPEP 710.06, you are required to restart the period for response.

Also, we have already relied on your statement during the telephone interview on September 8, 2008, that after consulting with your SPE, you had decided to withdraw the new ground of rejection and issue a replacement Final Office Action restarting the period for response.

Therefore, please issue the replacement Office Action restarting the period for response. I will continue to rely on the Interview Summary you faxed me yesterday, September 30, 2008

On October 2, 2008, the Examiner sent the attorney an e-mail stating as follows:

This email is to update you on the current status. We have decided to restart the period of reply. However, a first action with just an Interview Summary was approved which states that only the 101 rejections will be removed. The first action could not be removed in time (due to e-procesing [sic]) because we received your email explaining the reasons pursuant to MPEP 710.06 much later than the interview summary was processed.

Please be advised that a second action will be mailed which includes a replacement Final Office action and a second Interview Summary (to make of record) stating what you have requested in the first email you sent me. Since the record will be clear, you may continue to rely on the Interview Summary I faxed you, but once again, please note that the mailing of the second action (FOA and IS) will be processed shortly.

The MPEP 710.06 recites that we need to be notified within a month's time of the initial office action. Since you have clearly done that by contacting me within 5 days, you don't have to file an official response requesting the period of reply be reset.

The applicants subsequently received the Interview Summary mailed October 7, 2008, for the telephone interview of September 8, 2008, in which the Examiner states as follows:

Upon further review, the rejection of claims 1-4 and 48 under 35 USC 101 in the Final Office Action of September 3, 2008, is withdrawn.

The applicants subsequently received the replacement Final Office Action mailed October 17, 2008, that does not include the rejection under 35 USC 101 and restarts the period for response. Attached to the Final Office Action of October 17, 2008, is the revised Interview Summary Interview Summary for the telephone interview of September 8, 2008, in which the Examiner states as follows:

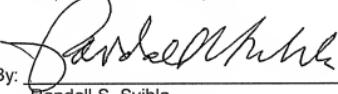
Upon further review, the rejection of claims 1-4 and 48 under 35 USC 101 in the Final Office Action of September 3, 2008, is withdrawn. A replacement Final Office Action restarting the period for response will be issued in due course. The applicants do not need to file a response to the Final Office Action of September 3, 2008.

The applicants will respond to the Final Office Action of October 17, 2008, in due course.

Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

By:


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